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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,450	09/28/2001	Harry S. Sowden	MCP-0296	5283

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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER	
TRAN, SUSAN T	
ART UNIT	**PAPER NUMBER**
1615	

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/966,450	SOWDEN, HARRY S.	
	Examin r	Art Unit	
	Susan T. Tran	1615	

-- The MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-10 and 14-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-10 and 14-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Receipt is acknowledged of applicant's Amendment filed 06/26/03, Information Disclosure filed 10/09/03 and 12/01/03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Although applicant pointed out that the bridging paragraph in pages 59-60 support the amended claim 9, it appears that applicant's specification does not provide support for the limitation "molding chambers are at a temperature below that of the reservoir". Further clarification is suggested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato et al. US 5,672,364 (Kato).

Kato teaches a tablet manufacturing apparatus that molds substrates comprising multiple molding chambers, multiple nozzles aligned with molding chambers where the nozzles are mounted on a rotor and engage and disengage the molding chambers (see abstract; figures 1-3G; C 3, L 64-C 5, L 64). Kato also teaches that the tablets of moist powder solidified in the mold cavities and pressed down and released out of the cavities by the ejector pins (column 5, lines 66 through column 6, lines 1-7; and figure 3G).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8, 9 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. US 5,672,364 (Kato) in view of Gutierrez et al. US 6,276,917 (Gutierrez).

Kato teaches a tablet manufacturing apparatus that molds substrates comprising multiple molding chambers, multiple nozzles aligned with molding chambers where the nozzles are mounted on a rotor and engage and disengage the molding chambers (see abstract; figures 1-3G; C 3, L 64-C 5, L 64). The apparatus is for manufacturing tablets of moist powder (abstract, and column 4, lines 49-61).

Kato does not teach heating a reservoir that supplies materials.

Gutierrez teaches heating a reservoir chamber to aid in compression of tablets (C 4, L 1-47). Thus, it would have been obvious to one of ordinary skill in the art to heat a reservoir chamber of Kato with the motivation of increasing cohesiveness of the tablets.

Claims 10, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato in view of Gutierrez and Honda et al. US 5,429,484 (Honda).

Kato and Gutierrez are relied upon for the reasons stated above. The references are silent as to the teaching of a valve in a flow path between a reservoir and nozzles where material is sucked back from the nozzles upon closing.

Honda teaches an apparatus used for liquid medicine comprising a valve in a flow path from a reservoir where a liquid is sucked back upon closing of the valve (see abstract, and figures). Thus, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Kato and Gutierrez using the valve in view of the teaching of Honda with the motivation of controlling the flow of material.

Response to Arguments

Applicant's arguments filed 06/26/03 have been fully considered but they are not persuasive.

Claims 8, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato et al. US 5,672,364 (Kato).

Applicant argues that Kato does not disclose a plurality of nozzles for feeding starting material into aligned molding chambers. Contrary to the applicant's argument, applicant's attention is directed to column 3, lines 38-54, where Kato teaches that two (plurality) mold cavities **7** are located right under the two filling holes **6**. Accordingly, Kato does teach the limitation being claimed.

Applicant argues that Kato does not disclose or suggest the combination of molding chambers and nozzles mounted on a common or shared rotor that rotates about a central axes. In response to applicant's argument that the reference does not show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., chambers and nozzles mounted on a common or shared rotor) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, while applicant is entitled to be his or her own lexicographer, applicant's attention is called to the figures and the description throughout the reference, for example, first table **2** and second table **3** are provided horizontally rotatably in such a manner that the first table laid on the second tablet at a station **B**. Accordingly, Kato teaches the limitation "molding chambers and nozzles mounted on a rotor capable of rotation about a central axis".

Claims 8, 9 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. US 5,672,364 (Kato) in view of Gutierrez et al. US 6,276,917 (Gutierrez).

Applicant argues that Gutierrez does not address any of the above identified shortcomings of Kato. Applicant notes that the reference contemplates heating the powder inside a conditioning chamber prior to a pelletizing step. Hence, Gutierrez fails to disclose a heated reservoir as claimed. In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant's specification does not provide support for the claimed limitation of a heated reservoir. Furthermore, the claimed invention does not exclude the powder to be heated after palletizing step.

Claims 10, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato in view of Gutierrez and Honda et al. US 5,429,484 (Honda).

Applicant argues that Kato fails to teach all the features being claimed, Gutierrez does not address these shortcomings and, in fact, fails to disclose or suggest the use of a reservoir that supplies the starting material directly to the nozzle. Honda does not provide the missing elements from the preceding rejections. Applicant further submits that the Examiner has improperly selected bits of the prior art using hindsight knowledge of the claimed invention to arrive at the claimed invention. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness

is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Kato does teach the limitation recited at least in claim 8 (see the above argument for the 102(b) rejection). Gutierrez is cited solely for the teaching of the heating reservoir to aid in compression of tablets. Honda is cited solely for the teaching of the valve.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (703) 306-5816 or (571) 272-0606 after 02/03/04. The examiner can normally be reached on M-R from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at (703) 308-2927 or 9571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600